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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,708	03/11/2005	Hideki Matsui	Q101073	9989
23373 7590 08/30/2007 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EXAMINER CHERNYSHEV, OLGA N	
			ART UNIT 1649	PAPER NUMBER
			MAIL DATE 08/30/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/527,708	Applicant(s) MATSUI ET AL.	
	Examiner Olga N. Chernyshev	Art Unit 1649	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15, 16, 21, 23-31, 33, 34, 39 and 41-47 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-13, 15-16, 21, 23-31, 33-34, 39 and 41-47 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1, drawn to a compound to inhibit the activity of a protein.

Group II, claim(s) 2, drawn to a compound to inhibit the expression of a gene.

Group III, claim(s) 3-5, drawn to antisense polynucleotides.

Group IV, claim(s) 6-10, drawn to antibodies.

Group V, claim(s) 11, 27-29, drawn to polynucleotides.

Group VI, claim(s) 12, drawn to method of screening a compound inhibiting the activity of a protein.

Group VII, claim(s) 13, drawn to a kit for screening a compound inhibiting the activity of a protein.

Group VIII, claim(s) 15, drawn to a method of screening a compound inhibiting the expression of a gene.

Group IX, claim(s) 16, drawn to a kit for screening a compound inhibiting the expression of a gene.

Group X, claim(s) 21, drawn to a method of treatment by inhibiting the activity of a protein.

Group XI, claim(s) 23, drawn to a compound promoting the activity of a protein.

Group XII, claim(s) 24, drawn to a compound promoting the expression of a gene.

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Group XIII, claim(s) 25 and 26, drawn to a composition comprising a protein.

Group XIV, claim(s) 30, drawn to a method of screening a compound promoting the activity of a protein.

Group XV, claim(s) 31, drawn to a kit for screening a compound promoting the activity of a protein.

Group XVI, claim(s) 33, drawn to a method of screening a compound promoting the expression of a gene.

Group XVII, claim(s) 34, drawn to a kit for screening a compound promoting the expression of a gene.

Group XVIII, claim(s) 39, drawn to a method of treatment by promoting the activity of a protein.

Group XIX, claim(s) 41, drawn to a method of treatment by administration of a compound inhibiting the activity of a protein.

Group XX, claim(s) 42, drawn to a method of treatment by administration of a compound inhibiting the expression of a gene.

Group XXI, claim(s) 43, drawn to a method of treatment by administration of an antisense polynucleotide.

Group XXII, claim(s) 44, drawn to a method of diagnosis using a protein.

Group XXIII, claim(s) 45, drawn to a method of treatment by administration of a compound promoting the activity of a protein.

Group XXIV, claim(s) 46, drawn to a method of treatment by administration of a compound promoting the expression of a gene.

Group XXV, claim(s) 47, drawn to a method of diagnosis using a polynucleotide.

2. The inventions listed as Groups I to XXV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Pursuant to 37 C.F.R. § 1.475 (a), Unity of invention before the International Searching Authority, an international and a national stage application shall relate to one invention only or to

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a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. As such, pursuant to 37 C.F.R. § 1.475 (b), the ISA/US considers that when an international or a national stage application containing claims to different categories of invention unity of invention exists if the claims are drawn only to one of the following combinations of categories:

- (1) A product and a process specially adapted for the manufacture of said product; or
- (2) A product and process of use of said product; or
- (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
- (4) A process and an apparatus or means specifically designed for carrying out the said process; or
- (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

3. Accordingly, the main invention (Group I, claim 1) comprises the first recited product, a compound or its salt inhibiting the activity of a protein of SEQ ID NO: 1. Since the subsequently recited products and methods do not share a special technical feature within the meaning of PCT Rule 13.2, then each of such products and methods accordingly defines a separate invention.

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4. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.
5. The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.
6. Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.
7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olga N. Chernyshev whose telephone number is (571) 272-0870. The examiner can normally be reached on 8:00 AM to 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Y. Chan can be reached on (571) 272-0841. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Olga N. Chernyshev, Ph.D.
Primary Examiner
Art Unit 1649

August 29, 2007